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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,834	06/27/2001	Lloyd Harmon Hancock	LL-113-R &D	3729

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EXAMINER

LOPEZ, CARLOS N

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 11/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/892,834

Applicant(s)

HANCOCK ET AL.

Examiner

Carlos Lopez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 1-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5. 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-21, drawn to smoking article and smoking article wrapper, classified in class 131, subclass 360.
- II. Claims 22-34, drawn to an apparatus for making a cigarette, classified in class 131, subclass 280.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process and apparatus such as by hand.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Brian Jones on October 28, 2002 a provisional election was made with traverse to prosecute the invention of making of a cigarette, claims 22-34. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Specification***

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 1) Claims 28 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. The terms "the outside and "the inside" of respective claims 28 and 29 lack antecedent basis

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**2)** Claim 22 is rejected under 35 U.S.C. 102(b) as anticipated by Adams et al (US 5,692,526). As shown in figure 1 by Adams, a cigarette maker discloses an adhesive applicator 348 between a bobbin from which wrapper (71) is being supplied and a garniture (342).

**3)** Claims 22-23 and 31-33 are rejected under 35 U.S.C. 102(b) as anticipated by Hall (US 4,174,720). Hall discloses a providing plug wrap adhesive to plug wrapper (Abstract). As shown in figure 1, a cigarette maker discloses an adhesive applicator (36) between a bobbin (21) for delivering a paper wrapper (22) and a garniture (31). The adhesive applicator includes an adhesive applicator shoe (37), applicator roll (48) and pattern roll (47).

As for claim 32, the applicator roll provides bands of adhesives to the paper wrapper (22).

As for claims 31 and 33, filter plug wrap adhesive is used since the paper wrapper is wrapping filter plugs.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4) Claims 24-29 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hall (US 4,174,720) as applied to claims 22 and 23 above and in further view of Ogura et al (US 5,634,477). Hall is silent disclosing heater upstream or downstream the adhesive applicator. However, as taught by Ogura providing a heater upstream and downstream an adhesive applicator provides adhesive that may be effectively dried in advance (Column 5, lines 40-48). At the time the invention was made it would have been obvious to a person of ordinary skill in the art to have provided heaters to Hall's adhesive applicator as taught by Ogura in order to advantageously evaporate any adhesive solvents.

As for claims 28 and 29, the adhesive applicator is capable of being placed on either side of the wrapper.

As for claim 34, absent any indication by Hall, it is assumed that plug paper wrappers have the conventional porosities such as those claimed by applicant.

5) Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hall (US 4,174,720) as applied to claims 22 and 23 above and in further view of admitted prior art (Admission). Hall discloses the applicator roller being smooth or grooved (Figure 5) but

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is silent disclosing transverse grooves spaced circumferentially around the periphery of the roller. However, applicant's Admission discloses that applicator roll having transverse grooves spaced circumferentially around the periphery of the roller is well known in the art (Page 17 lines 19-23). At the time the invention was made it would have been obvious to a person of ordinary skill in the art to have use the admitted prior art's pattern rollers in order to provide alternative method of applying adhesive to a paper wrapper.

**6)** Claims 22-23, 28-29 and 31-34 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Collins et al (US 5,450,863). Collins discloses an apparatus and method for applying adhesive to a cigarette wrapper (Column 2, lines 64-65). As shown in figure 1a, a cigarette maker discloses an adhesive applicator (37) downstream a bobbin (31) for delivering a paper wrapper (10). The adhesive applicator (34) includes an adhesive applicator shoe (39), applicator roll (300) and pattern roll (37). Collins teaches that the claimed invention sets out to improve the adherence of the paper strips onto the base web which would then be conveyed to a garniture (Column 2, lines 10-39). Thus, it is inherent or the least obvious to one of ordinary skill in the art that the wrapper (10) would then be conveyed to a garniture, downstream the adhesive applicator (34).

As for claims 28-29, the adhesive applicator is capable of being placed on either side of the wrapper.

As for claims 31 and 33, cigarette seam adhesive is used since the paper wrapper is wrapping smoking rod.

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As for claim 32, the applicator roll (300) provides bands of adhesives (301) to the paper wrapper (10).

As for claim 34, absent any indication by Collins, it is assumed that cigarette paper wrappers have the conventional porosities such as those claimed by applicant.

7) Claims 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Collins et al (US 5,450,863) as applied to claims 22 and 23 above and in further view of Ogura et al (US 5,634,477). Collins is silent disclosing heater upstream or downstream the adhesive applicator. However, as taught by Ogura providing a heater upstream and downstream an adhesive applicator provides adhesive that may be effectively dried in advance (Column 5, lines 40-48). At the time the invention was made it would have been obvious to a person of ordinary skill in the art to have provided heaters to Hall's adhesive applicator as taught by Ogura in order to advantageously evaporate any adhesive solvents.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lopez whose telephone number is (703) 605-1174. The examiner can normally be reached on Mon.-Fri. 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7718 for regular communications and (703) 305-3599 for After Final communications.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.



STEVEN P. GRIFFIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

C.L

November 14, 2002